UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte VALENTIN OPRESCU-SURCOBE and SHAHAB M. SAYEEDI

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Appeal 2009-001,978
Application 10/823,185
Technology Center 2600

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Decided:[1] June 15, 2009

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Before MAHSHID D. SAADAT, JOHN A. JEFFERY, and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 2, 6-9, 12-14, 17, and 27-38 (Br. 5).[2] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

According to Appellants, the invention includes a wireless presence proxy (WPP) that wirelessly monitors messaging responses of a mobile station (MS). Based upon this monitoring, the WPP infers the presence state change for the MS and maintains MS location information. The messaging responses do not explicitly specify a presence state or state change for the MS. The WPP infers a MS presence state from MS messages indicating that the MS powers down, deregisters, enters an unavailable mode, hands off to an outside wireless communication network, or involves other communication. (Spec. 3:9-16; 6:19-30).

Exemplary claims 1 and 34 follow:

1.   A method for enabling wireless presence-based services comprising:

monitoring, by a wireless communications network, messaging and messaging responses of a mobile station (MS), wherein the messaging and the messaging responses do not specify a presence state of the MS or a presence state change by the MS;

inferring, by the wireless communications network, a change in the presence state of the MS based upon the monitoring, wherein inferring comprises inferring the MS presence state has changed when the presence state of the MS indicates that the MS is present and messaging is detected

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[2] Appellant's Brief (filed May 17, 2007) ("Br.") and the Examiner's Answer (mailed Sept. 14, 2007) ("Ans.") detail the parties' positions.

that indicates MS activity from the group consisting of powering down, deregistering, entering an unavailable mode, handing off outside the wireless communication network, and involved in other communication;

communicating, by the wireless communications network, the state change to a presence server.

34.   A method comprising:

receiving, by a base station (BS) from network equipment, a short data delivery message;

signaling by the BS a mobile station (MS) in response to the short data delivery message;

sending by the BS a short data acknowledgment message to the network equipment indicating whether a response from the MS was received for the signaling of the MS by the BS.

The Examiner relies on the following prior art references:

Chen	US 2003/0157945 A1	Aug. 21, 2003
		(filed Feb. 21, 2002)
Blackett	US 2004/0138834 A1	Jul. 15, 2004
		(filed Jun. 29, 2001)
Magee	US 2004/0198379 A1	Oct. 7, 2004
		(filed Aug. 28, 2002)

The Examiner rejected claims 34-38 as anticipated under 35 U.S.C. § 102(e) based on Chen; claims 1, 6, and 28 as obvious under 35 U.S.C. § 103(a) based on Magee and Blackett; and claims 2, 7-9, 12-14, 17, 27, and 29-33 under 35 U.S.C. § 103(a) based on Magee, Blackett, and Chen.

<center>ISSUES</center>

Did Appellants demonstrate that the Examiner erred in finding that Chen discloses "sending by the BS a short data acknowledgment message to the network equipment indicating whether a response from the MS was received for the signaling of the MS by the BS" as required by claim 34?

Did Appellants demonstrate that the Examiner erred in finding that Magee and Blackett collectively teach a network that monitors "messaging responses [that] do not specify a presence state" and infers "a change in the presence state of the MS based upon the monitoring," wherein inferring comprises detecting messages "that indicate[] MS activity from the group consisting of powering down, deregistering, entering an unavailable mode, handing off outside the wireless communication network, and involved in other communication" as set forth in claim 1?

PRINCIPLES OF LAW

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Under § 102, anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Under § 103,

> "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" . . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim,

> for a court can take account of the inferences and creative steps
> that a person of ordinary skill in the art would employ.

KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 418 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). "On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness . . . ." *Kahn*, 441 F.3d at 985-986 (citation omitted).

"[W]hen . . . the prior art . . . is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result," *KSR,* 550 U.S. at 416. "'Our suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense.'" *Id*. at 421 (citation omitted).

"It is the applicant's burden to precisely define their invention, not the PTO's." *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) ("The problem in this case is that the appellants failed to make their intended meaning explicitly clear.").

Claims 34-38 - Anticipation Based on Chen

Findings of Fact (FF)

Chen

1. Chen's message delivery system includes service provider packet data service nodes (PDSNs), base station controllers (BSCs), packet control functions (PCFs), mobile station controllers (MSCs), and mobile stations (MSs). (¶¶ 0002, 0006-0009, 0022).

2. When a PCF receives packet data from a PDSN destined for a particular dormant MS, the PSF may deliver the data to a BSC in a short

data burst (SDB) format. The BSC may send the data in SDB format either directly to the mobile, or if unsuccessful, send it in SDB format to the MSC for delivery to the MS via an application data delivery service (ADDS) page. (¶¶ 0046-47; Fig. 4).

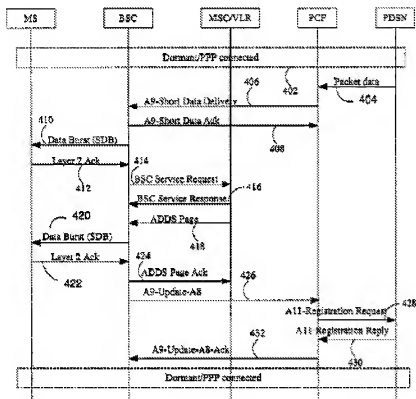   3. Chen's Figure 4 appears below:

    Figure 4, reproduced above, depicts Chen's MS SDB delivery signaling details for one embodiment (Chen ¶¶0015, 0048).

    4. As seen *supra* (FF 3) and as described by Chen, the PCF delivers data 406 in short data bursts on an A9 connection to a BSC. The BSC may send an SDB 410 directly to an MS and then wait for a response acknowledgement 412 from an MS. If the MS fails to acknowledge the

delivery, the BSC may indicate this by sending an SDB to the MSC in a
BSC service request message 414. (¶¶0049-52).

    5. The MSC then may send an ADDS 418 message to the BSC with
the SDB included therein, and the BSC may then forward the SDB 420 to
the MS which then sends an acknowledgement 422 back to the BSC. In
response, the BSC may then either send an acknowledgement 424 to the
MSC or 426 to the PCF "to indicate successful transmission of the SDB to
the mobile [i.e., MS]." (¶¶ 0052-0053).

<div align="center">Analysis</div>

    Appellants' arguments (Br. 10-12) focus on claim 34. In particular,
Appellants argue (Br. 12) that the Examiner (*see* Ans. 3-5) should be
reversed because: "message 426 does not indicate whether a response from
the MS was received for the signaling of the MS <u>by the BS</u>, as the claim
recites." Appellants base this argument on the following reasons (Br 12.):
"Chen [0053] teaches that message 426 is sent 'to indicate successful
transmission of the SDB to the mobile' <u>by the MSC</u> via ADDS paging
mechanism. Chen [0052] and Chen [0054] teach that the BSC may send the
SDB to the MSC instead of the MS for delivery via ADDS paging."

    Chen does not factually support Appellants' reasoning. As the
Examiner found (Ans. 12-14), and as Chen's Figure 4 depicts and Chen
describes (FF 1-5), the BSC sends either the SDB 410 or 420 to the MS. In
other words, the MSC does not send the SDB directly to the MS, contrary to
Appellants' implied argument. Consequently, either acknowledgement 424
or 426 acknowledges the SDB 410 or 420 "signaling of the BS by the MS";

and therefore, either 424 or 426[3] constitutes "sending by the BS a short data acknowledgment message to the network equipment indicating whether a response from the MS was received for the signaling of the MS by the BS" as required by claim 34.

Therefore, we will sustain the Examiner's rejection of claim 34, and claims 35-38 not separately argued.

Claims 1 , 6, and 28 - Obviousness Based on Magee and Blackett

Findings of Fact

Appellants' Disclosure

6. As background, Appellants state:

> Presence services, such as instant messaging (IM), are well-known to Internet users. These services are also part of 3rd generation (3g) wireless offerings. However, the current wireless paradigm does not handle these services very efficiently. For example, existing presence servers typically maintain presence information by periodically pinging the target mobile stations (MS) and use the response or lack of it, as a presence "heart beat" signal.

(Spec. 2:24-29 (under "Background of the Invention")).

7. Appellants' invention monitors messages that do no explicitly specify a presence, but rather, the network infers a change in the presence state of an MS based on the message monitoring (Spec. 3:23-29). Appellants briefly describe the system as follows: "Thus, based upon this

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[3] As another alternative, message 414 constitutes "a short data acknowledgement to the network indicating whether a response from the MS" was received. That is, if the MS fails to acknowledge the SDB delivery, the BSC may indicate this by sending an SDB to the MSC in a BSC service request message 414 (FF 3, 4).

monitoring, the WPP infers the present state / change for the MS and maintains MS location information" (Spec. 3:13-14).

    8. To infer presence, Appellants employ certain MS message types already provided on existing systems that do not provide presence services, including "MS indications that it is powering up or down, registering or deregistering, entering or exiting an unavailable mode, handing off outside or into wireless communication network 210, or involved in or completing other communication" (Spec. 6:7-11)

Magee

    9. Magee's system uses a presence server 70 and location server 60 to deliver location specific messages from specific businesses to a mobile device 10 (Abstract). For example, a subscriber, upon entry into a mall, can elect to receive sporting goods messages (¶0021).

    10. Magee's process involves powering on the mobile station (MS) (110) and determining if the mobile station has the presence feature (112) (Fig. 2; ¶0016).

    11. Magee, as background, discloses that newer telephone systems, including current 2.5G and 3G mobile systems, can monitor the subscriber's geographic location (¶0004). On the other hand, "[o]lder mobile telephone systems did not locate the user per se" (¶0002). These older systems hand off the mobile telephone from one antenna to another in a different cell (*id.*). With respect to Magee's disclosed invention, "[t]ypically, the mobile station 10 determines its geographic location and updates location server 60 with its location" ¶0015).

    12. Magee refers to "presence" in terms of 1) location; i.e., "presence in the mall" (¶0021), and 2) in terms of telephone status; i.e.; "the mobile

device then sends the user selected presence status to the presence server 70.

Sample statuses are busy, away, online, etc" (¶0019).

Blackett

    13. Blackett also refers to several types of "presence," including

location or status types:

> Presence is a way for a device to make it's [sic] connection or
> availability known or available to the network it is connected
> to. . . . There are several types of presence that can be used to
> signify the presence of a recipient or sender. Temporary
> Presence indicates where, on the network, the recipient was
> several minutes ago; Predicted Presence indicates where the
> sender thinks the recipient is now; Network Presence indicates
> the recipient client is logged in somewhere . . .and Real
> Presence indicates that the recipient is logged in and
> communicating. . . . It can be appreciated by one skilled in the
> art that there are several variations, extensions and permutations
> of the above types of presence such as 'away', 'do not disturb',
> sleeping' etc. Presence can also . . . *offer insight* into other
> necessary information. For instance *presence may also indicate
> information such as location*, geographic, logical or physical, or
> other application specific data . . . .

(¶ 0127) (emphasis added).

    14. Blackett discloses another example of presence: "This feature

ensures that if a client goes offline, but is unable to send an error, the server

will automatically update the client presence to show a presence error 1570

(¶ 0134)."

    15. Blackett categorizes the types of events that "trigger a presence

change" as either related to: 1) the detection of "an event which may alter its

[i.e. the client] status or presence or 2) the elapse of a pre-determined time

"without any event then the presence or status is determined again."
(¶ 0133).

<div align="center">Analysis</div>

Claims 1 and 6

Appellants focus on claim 1 and argue as follows (Br. 13):

> [T]he claims recite that . . . the messaging responses monitored
> <u>do not specify</u> a presence state of the MS or a presence state
> change by the MS. Assuming one equates 'location' with
> 'presence state,' as it appears the Examiner is doing, Magee
> [0015] appears to teach away from this portion of the claim
> language with the MS determining its geographic location and
> then updating the location server 60 with its location, i.e.,
> specifying its location.

Appellants' argument is not persuasive. While Magee teaches that
newer telephone phone systems may explicitly identify location, Magee also
teaches that older telephone systems do not identify location "per se," but
rather, infer such location by handing off the phone from one cell antenna to
the next (*see* FF 11). Moreover, by describing the use of such specific
location information in the newer systems as "typical[]," Magee does not
preclude the use of the older systems which merely infer location. Thus,
contrary to Appellants argument, Magee does not teach away from the claim
limitation of "not specify[ing] a presence state."

Appellants fail to identify clearly what the clause "do not specify a
presence state" in claim 1 embodies, but, in light of the clause "inferring the
MS presence state has changed," the claim and disclosure indicate that the
first clause does not preclude inferring, but does preclude explicitly
specifying, any type of presence state change, including location or power
state changes of the telephone, for example (*see* FF 6-8).

Thus, the Examiner's unchallenged finding (Ans. 14) that Magee, however, <u>does not specify the on/off state of the MS</u>" constitutes an alternative reasonable unspecified status, in addition to the unspecified location status described *supra*. Hence, Magee discloses the argued limitations of claim 1 pertaining to "not specify[ing] a presence state or . . . a presence state change." That is, Magee teaches detecting the presence of an MS after it powers on (FF 10), which reasonably suggests "not specify[ing]" the power status or power status change. For example, the amount of power being used or consumed or the specific MS power state, such as idle, is not specified, as the Examiner generally reasoned (*see* Ans. 14, 15), without rebuttal by Appellants.

With respect to the "inferring" clause of claim 1, Appellants argue that Magee and Blackett (Br. 14) fail to suggest inferring a presence state change from one of the specific monitored message indications recited: "powering down, deregistering, entering an unavailable mode, handing off outside the wireless communication network, and involved in other communication." This argument also lacks merit.

As discussed *supra*, Magee teaches that older systems infer location by a similar "handing off" as that recited in claim 1 (*see* FF 11). Blackett also teaches a wide variety of inferences or indications obtainable from various types of messages, including the inference of geographic location – a teaching similar to that of Magee. For example, Blackett states: "It can be appreciated by one skilled in the art that there are several variations, extensions and permutations of the above types of presence such as 'away', 'do not disturb', sleeping'" - any one of which Blackett suggests can be used to infer other presence states, including location (*see* FF 14).

Blackett's away, off-line, sleeping, or timed out presence statuses (FF 13-15), or Magee's away or on-line statuses (FF 12), reasonably relate to one of Appellants' "powering down," "unavailable," or "other communications" presence state message activity indicators. (As the Examiner determined (Ans. 15), claim 1 requires only one such type of message activity indicator from the "group consisting of" the message indicators.) Further, Appellants describe the whole list of specific message indicators recited in claim 1 as known MS messages (FF 8).

Therefore, the Examiner's reliance on Blackett's paragraph 0133 (Ans. 15) as suggesting an inference of "powering down," based on a lack of detected activity after an elapsed time, is reasonable. Further, skilled artisans would have recognized that paragraph 0133 categorizes and therefore includes the various known types of presence events described in Blackett and discussed *supra*, further bolstering the Examiner's findings (*see* FF 13-15). Appellants, at most, merely substitute known data messages into a known process of inferring presence from similar such data messages.[4] "[W]hen . . . the prior art . . . is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR,* 550 U.S. at 416 (citation omitted).

Accordingly, we will sustain the Examiner's rejections of claim 1 and dependent claim 6, not separately argued.

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[4] Moreover, under alternative reasoning, the specific message types constitute nonfunctional descriptive material, because the claimed process does not change based on the specific message activity detected. Non-functional descriptive material cannot render patentable an otherwise unpatentable product or process. *In re Ngai,* 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Ex parte Curry,* 84 USPQ2d 1272, 1275 (BPAI 2005) (Informative Opinion) (*aff'd*, Rule 36, Fed. Cir., slip op. 06-1003, June 2006).

Claim 28

Appellants present similar arguments (Br. 14-16) to those presented for claim 1. Claims 1 and 28 are similar in scope. Accordingly, we will also sustain the Examiner's rejection of claim 28 for reasons similar to those outlined above with respect to claim 1.

Claims 2, 7-9, 12-14, 17, 27, and 29-33 - Obviousness Based on Magee, Blackett, and Chen

Appellants' nominal arguments (Br.16) do not present separate arguments for patentability. Appellants primarily rely on arguments presented for claims 1 and 28. Accordingly, we will also sustain the Examiner's rejection of claims 2, 7-9, 12-14, 17, 27, and 29-33 for reasons similar to those outlined above with respect to claims 1 and 28.

CONCLUSION

Appellants did not demonstrate that the Examiner erred in finding that Chen discloses "sending by the BS a short data acknowledgment message to the network equipment indicating whether a response from the MS was received for the signaling of the MS by the BS" as required by claim 34. Appellants also did not demonstrate that the Examiner erred in finding that Magee and Blackett collectively teach a network that monitors "messaging responses [that] do not specify a presence state" and infers "a change in the presence state of the MS based upon the monitoring," wherein inferring comprises detecting messages "that indicate[] MS activity from the group consisting of powering down, deregistering, entering an unavailable mode, handing off outside the wireless communication network, and involved in other communication," as set forth in claim 1.

DECISION

We affirm the Examiner's decision rejecting claims 1, 2, 6-9, 12-14, 17, and 27-38.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD

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